REMARKS

Applicants' attorney wishes to thank the Examiner for the careful consideration given this case. Claims 1-10 were pending in this case, Claims 11-13 having been withdrawn. Herein, Claim 1 is amended. Claims 4, 5, and 7 are cancelled.

This response addresses those issues raised in the Office Action dated August 19, 2003. It is believed that the present amendments and following remarks render all pending claims allowable. Reconsideration of the claims as amended is respectfully requested.

The Examiner rejects Claim 1-4 and 6-10 under 35 U.S.C. § 103(a) as being unpatentable over Baer *et al.* (U.S. Patent No. 5,985,085). The Examiner further rejects Claims 1-10 under 25 U.S.C. § 103(a) as being unpatentable over Baer et al. in view of Schütze et al. (Cellular and Molecular Biology 44(5):735-746 (1998)). The arguments presented hereinbelow are applicable to both rejections put forth by the Examiner.

The amended Claim 1 is clearly non-obvious over Baer et al. and Schütze et al., either singly or in combination. In the present invention, unexpected, advantageous effects are achieved by the combination of the aramid film, UV laser, and the colored film having a thickness of 3 to 6 μm. The Examiner's attention is directed to Table 1 of Example 2 on Page 12 of the present application. In the examples of the present invention wherein the yellow aramid film is used, and the thickness of the film is between 3.9 and 4.2 μm, the properties of improved adhesion suitability to a glass slide, improved microdissection suitability, and improved cutting sharpness can be achieved simultaneously. In contrast to the present invention, the data regarding the Control Examples clearly demonstrate that when the thickness is 1 μm or 7.4

μm, at least one of the aforementioned properties of improved adhesion suitability to a glass slide, improved microdissection suitability, and improved cutting sharpness is lost.

While it may be true that Baer et al. generally and vaguely discloses the desirability of using a thin film of 50 μm or less, the range disclosed by Baer et al. includes both the operable range of 3 to 6 μm and the inoperable thickness of 1.0 and 7.4 μm. The present invention, is directed to the unexpected advantageous effect that can be achieved by using a film having the thickness of 3 to 6 μm. This thickness range is clearly defined and is not obvious from the vague disclosure of Baer et al. The Schütze et al. references does not cure this deficiency of Baer et al.

Objective evidence and secondary considerations such as unexpected results, commercial success, long felt need, failure of others, copying by others, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP § 2141.01. In the present circumstances, the specification of the presently-pending application clearly contains the evidence. It is respectfully submitted that in light of these data, the present obviousness rejection is untenable and should be withdrawn. Reconsideration of this obviousness rejection is respectfully requested.

Further, the present obviousness rejections are inappropriate because the claims, in their present form, recite the use of an aramid film. Neither, Baer et al., nor Schütze et al. recite the use of an aramid film. As the Examiner is aware, to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested in the cited references. MPEP § 2143.01. It is submitted that the cited references do not satisfy this requirement for Claims 1-3, 6, and 8-10 in their present form. Accordingly, on those grounds alone the present obviousness rejection is

inappropriate and should be withdrawn. Reconsideration of this obviousness rejection is respectfully requested.

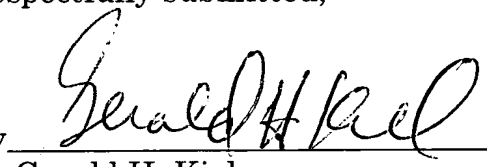
Further, the present obviousness rejection that employ Schütze et al. is inappropriate because Schütze et al. teaches away from the present invention. Schütze et al. teach that a UV laser method may be used with a 1-3 μm thin polyester foil. This range is clearly outside of the claimed range and instead includes the thickness of 1.0 μm, which is clearly demonstrated to be undesirable in the specification of the present invention (*see* above). Reconsideration and withdrawal of the present obviousness rejection is respectfully requested.

In summary, none of the cited references teach or fairly suggest, either singly or in combination, the unexpected and advantageous effect of the present invention, namely that the desirable properties of adhesion to a glass slide, microdissection suitability, and cutting sharpness can be achieved by using the combination of aramid film, a UV laser, and a film thickness of 3 to 6 μm. Therefore, the pending claims are clearly non-obvious in light of the cite prior art. Reconsideration and withdrawal of the pending obviousness rejections is respectfully requested.

In view of the amendments to the claims and the remarks presented herein, it is respectfully submitted that the present application is in condition for final allowance and notice to such effect is requested. If the Examiner believes that additional issues need to be resolved before this application can be passed to issue, the undersigned invites the Examiner to contact him at the telephone number provided below.

Respectfully submitted,

Dated: November 19, 2003

By 

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